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IN THE

Supreme Court of the United States

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CHARLES ELMORE GOSLEY  
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October Term, 1948  
No. 372.

LEROY J. LEISHMAN,

*Petitioner.*

vs.

RADIO CONTAINER COMPANY and GENERAL INSTRUMENT  
CORPORATION,

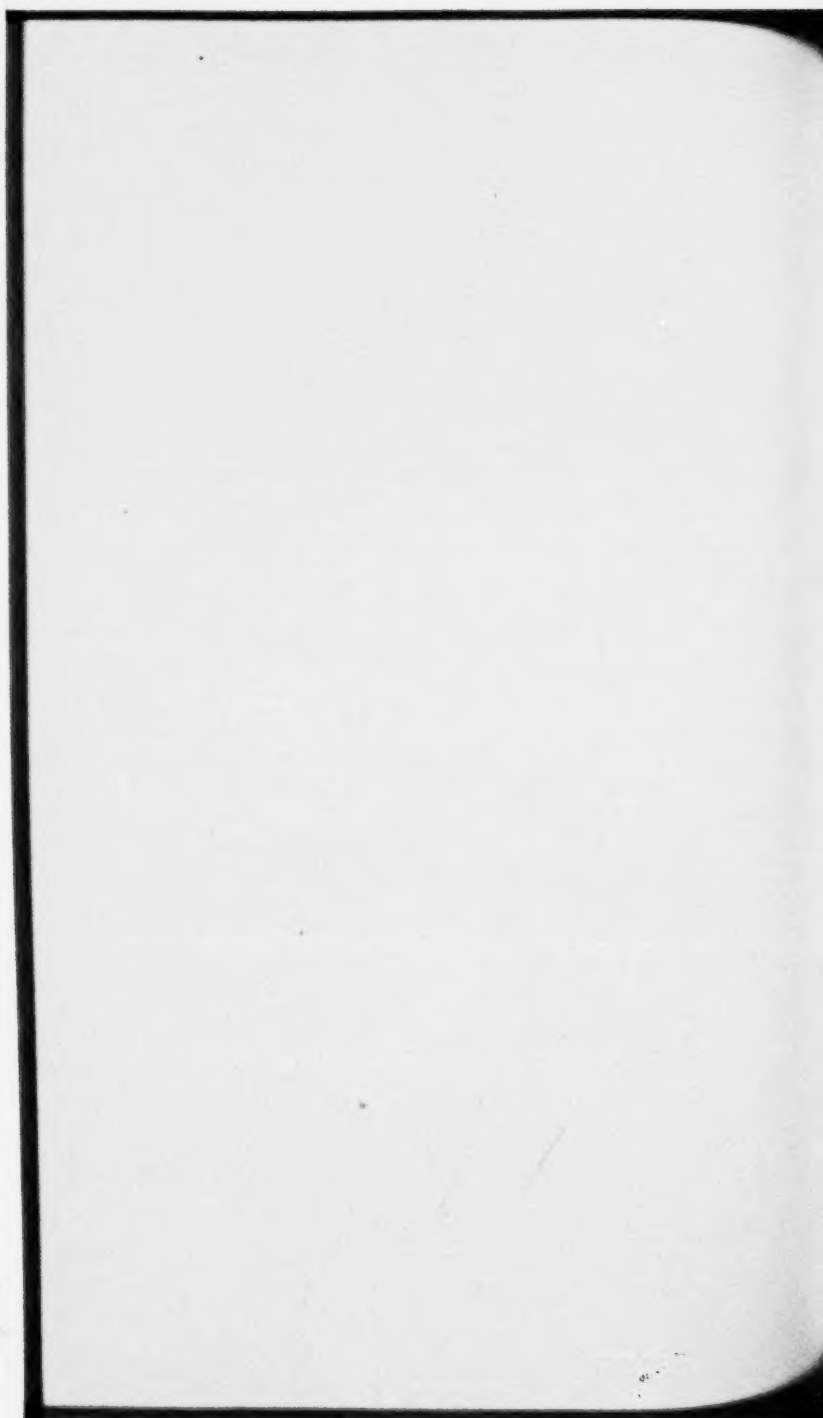
*Respondents.*

PETITIONER'S REPLY BRIEF

Including Supplementary Information Promised in  
Petition for Writ of Certiorari.

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The Recent Decision of the Tenth Circuit Court of Appeals in the Richards and Conover Case Has Continued and Sharpened the Conflict Between Courts in the Ninth and Tenth Circuits, Upon Which Petitioner Relied as the First Reason for Allowance of the Writ.

A direct conflict between the appellate court's decision herein and the decision of a district court within the Tenth Circuit was one of the reasons relied upon for allowance of the writ (see petition, p. 8). The Court of Appeals for the Ninth Circuit in the instant case affirmed a summary judgment that the claims at issue are not infringed, while the United States District Court for the

Western District of Oklahoma, in the case of *Leishman v. The Richards and Conover Company*, Civil Action No. 2155, had held the same accused devices to be clear infringements of the same claims. The Oklahoma court's decision was in disagreement with an earlier decision of non-infringement by the Court of Appeals for the Ninth Circuit in the case of *Leishman v. Associated Wholesale Electric Company*, 137 F. 2d 722, upon which the present decision was based. The said *Associated* decision wiped out the lower court's holding in that case that the claims were invalid for want of invention, and ruled *de novo* that there was no infringement without any findings on this issue from the lower court. In that case, the accused devices were patent-wise the same as those accused herein.

The petition for a writ of certiorari herein stated that the decision of the Oklahoma court in *The Richards and Conover* case was on appeal, and that petitioner would advise this Honorable Court of the decision of the Court of Appeals for the Tenth Circuit in that case.

The latter court has now rendered its opinion (at this date unreported), leaving the lower court's holding of infringement undisturbed, but reversing the lower court on the issue of validity. The conflict on the issue of infringement between the courts in the two circuits thus still remains.

Not only did the Court of Appeals for the Tenth Circuit fail to reverse the lower court on the issue of infringement, but it went out of its way to quote from the opinion in the *Associated* case, *supra*, and to point out that it could not go along with the Court of Appeals for the Ninth Circuit in its reasoning that the claims were not infringed and that the operating plungers of the accused devices are not mechanical equivalents of the lever shown

in the patent. It must be here remembered that the opinion herein was based solely upon the *Associated* decision, both the District Court and the Appellate Court following the earlier case upon the basis of *stare decisis*.

The comments of the Court of Appeals for the Tenth Circuit on this subject are particularly significant, because the issue of infringement was a moot question as far as that court was concerned in view of its holding that the claims at issue were invalid; yet it saw fit to devote three paragraphs in its decision and two paragraphs in a footnote to the *Associated* case and to the contention that "the lever in the device of the patent in suit and the plunger in the accused device are not mechanical equivalents"—the point on which the *Associated* case was decided. The Court of Appeals for the Tenth Circuit also referred to one of its own decisions and to a paragraph in Walker on Patents, both of which support the holding of the United States District Court for the Western District of Oklahoma that these elements *are* mechanical equivalents.

The brief for respondents (p. 2) gives an entirely misleading account of the affect of the Tenth Circuit decision, as follows:

"There is *no* conflict between the decision herein and the decision of any other court. The United States District Court for the Western District of Oklahoma had held the patent valid and infringed in *The Richards and Conover* case, *supra*, but since the filing of the petition for writ of certiorari in the instant case, the Court of Appeals for the Tenth Circuit, on November 15, 1948, *reversed* such holding and held the patent invalid for lack of invention and as anticipated by the prior art." (Emphasis added.)



The Court of Appeals for the Tenth Circuit did *not* reverse the lower court on the subject of infringement—the only issue that has any pertinence here—and the conflict between the Court of Appeals for the Ninth Circuit and the United States District Court for the Western District of Oklahoma not only still stands, but has now been recognized by the Court of Appeals for the Tenth Circuit, which has supported its lower court on that issue. The fact that the Court of Appeals for the Tenth Circuit has held the claims invalid<sup>1</sup> in no way affects the instant case, because the patent, so far as the Ninth Circuit is concerned, is still valid.

In discussing the decision of the Court of Appeals for the Ninth Circuit in the *Associated* case, *supra*, which the Ninth Circuit followed and reaffirmed in its decision herein,<sup>2</sup> the Court of Appeals for the Tenth Circuit stated:

“In *Leishman v. Associated Wholesale Electric Co.*, 36 F. Supp. 804, the court adjudged claims 7 to 11,

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<sup>1</sup>A petition for rehearing on the holding of invalidity has just been filed in the Tenth Circuit; and if such holding is not reversed, a petition for writ of certiorari will be filed in that case on the ground that the decision is in conflict with the situation in the Ninth Circuit, where the appellate court in the *Associated* case, *supra*, wiped out the lower court's holding that the claims were invalid for want of invention and thus restored the presumption of validity to the patent. The decision of the Court of Appeals for the Tenth Circuit, instead of wiping out the conflict *as alleged by respondents*, has brought the conflict on infringement into sharper focus and added a new conflicting issue on which there are likewise no concurrent findings between the appellate courts.

<sup>2</sup>In the instant case, the lower court did not rule on the subject of validity, the motion for summary judgment having been confined to the single issue of infringement. Its summary judgment of non-infringement merely followed the appellate court's *Associated* decision on the basis of *stare decisis*. In affirming the lower court's summary judgment, the Court of Appeals for the Ninth Circuit adopted and reaffirmed its decision in the *Associated* case in which it held that the accused device did not infringe because it was operated by plungers instead of levers. It said [R. 263]: “The California court was not at liberty to overrule it.”

inclusive, invalid for want of invention. On appeal, the Ninth Circuit held that if claims 7 to 11, inclusive, did not include levers, they were not for the same invention as the original patent and were, therefore, invalid, and that if they did not include levers, the plungers and the levers not being mechanical equivalents, such claims were not infringed by an accused device which contained no lever, and concluded it was not necessary to pass on the validity of claims 7 to 11, inclusive. [The Tenth Circuit decision then referred to a footnote 2 in which it quoted two paragraphs from the Ninth Circuit decision in the *Associated* case.]

"There, as here, the alleged infringing device employs only one rocker and one set of corresponding tappets, and the tappets are mounted on and moved by plungers, not levers.

"However, claims 7 to 11, inclusive, embrace a single rocker and corresponding adjustable tappets mounted on pivots, means for moving each tappet so one of its sides engages one arm of the rocker and rotates the rocker until the other side of the tappet engages the other arm of the rocker, and *they do not specifically embrace a lever means for carrying and moving the tappets; and we are unwilling to rest our decision on the narrow ground that the lever in the device of the patent in suit and the plunger in the accused device are not mechanical equivalents.*" (Emphasis added.)

Footnote No. 3 of the Tenth Circuit decision then referred to the previous Tenth Circuit decision in *Steiner Sales Co. v. Schwartz Sales Co.*, 98 F. 2d 999, at page 1012, and to Walker on Patents, Deller's Edition, Volume 3, page 1706, Section 468. In the *Steiner Sales Co.* deci-

sion, at the page referred to, the Court of Appeals for the Tenth Circuit decided the specific point at issue here, and it decided it in a manner just opposite from the Ninth Circuit's holding herein. In the instant case, the rectilinearly movable plunger of the accused devices is guided in its path by means of *grooves* in the plates provided for the purpose, while the corresponding lever in the patent moves around a pivot or *hinged joint*. At the page to which the Tenth Circuit has referred, its *Steiner Sales Co.* decision said:

“We are of the opinion that a device having ribs which project from the base of the inner section, extend along the sides thereof and travel in *grooves* or *channels* in the side walls of the outer section, and by means of which the inner section may be moved *back and forth* horizontally, responds to the claims in suit equally with one where the inner section may be tipped back and forth *on a hinged joint*.” (Emphasis added.)

Thus, the Court of Appeals for the Tenth Circuit, in referring to this holding and specific page in its *Steiner* decision, has made it very clear that it does not agree with the Court of Appeals for the Ninth Circuit in its ruling that the plungers of the accused devices which travel back and forth in grooves or channels do *not* respond to the claims in suit equally with the lever which is moved back and forth on a pivot or hinged joint.

Section 468 in Walker, to which reference is also made in footnote 3 of the Tenth Circuit's decision in *Leishman v. The Richards and Conover Company*, reads as follows:

“§468—Tests of Equivalency. Substantial Identity of Performance. Function must be performed in

substantially the same way by an alleged equivalent, as by the thing of which it is alleged to be an equivalent, in order to constitute it such. (*Burr v. Duryee*, 1 Wall. (68 U. S.) 531, 573, 17 L. Ed. 650 (1864); *Werner v. King*, 96 U. S. 218, 230 (1877); *Dryfoos v. Wiese*, 124 U. S. 32, 37 (1888); *Forncrook v. Root*, 127 U. S. 176, 181 (1888); *Sargent v. Burgess*, 129 U. S. 19 (1889); *Carter Mach. Co. v. Hanes*, 70 Fed. 859, 865 (1895); *Pittsburgh Meter Co. v. Pittsburgh Supply Co.*, 109 Fed. 644 (1901); *Farmers' Mfg. Co. v. Spruks Mfg. Co.*, 119 Fed. 644 (1901); *McDonough v. Johnson-Wentworth Co.*, 30 F. (2d) 375, 384, C. C. A. 8 (1928), cert. den. 280 U. S. 572, 74 L. Ed. 624; *Farrington v. Haywood*, 35 F. (2d) 628, 631, C. C. A. 6 (1929); *E. van Noorden Co. v. Cheney Co.*, 75 F. 2d 298, 300, C. C. A. 1 (1934); *Chicago Forging & Mfg. Co. v. Bade-Cummins Mfg. Co.*, 63 F. (2d) 928, C. C. A. 6 (1933); *Chapman-Stein Co. v. Rust Engineering Co.*, 57 F. (2d) 38, 42, C. C. A. 3 (1932).)

"This substantial sameness of way is not necessarily an identity of merit (*Brush v. Condit*, 132 U. S. 39, 49 (1889); *Standard Folding Bed Co. v. Osgood*, 58 Fed. 583, 584 (1893); *National Binding Machine Co. v. James D. M'Laurin Co.*, 186 Fed. 992 (1911)), nor a theoretical scientific sameness. (*Gordon v. Warder*, 150 U. S. 47, 52 (1893).) In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever

and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way. (Turrell v. Spaeth, 3 Bann. & Ard. 458, Fed. Case. No. 14,269 (1878).) Levers and springs are also used interchangeably in the arts (Gouid Coupler Co. v. Pratt, 70 Fed. 622, 627 (895)), and levers of a different class constitute examples of equivalency. (Star Can Opener Co. v. Owen Dyneto Co., 16 F. (2d) 353, C. C. A. 2.)”

These specific references, cited by the Court of Appeals for the Tenth Circuit in support of its *Richards and Conover* opinion, leave no doubt that its views are in conflict with those of the Court of Appeals for the Tenth Circuit herein.

Apparently attempting to argue the merits of the issue as to the equivalency of the plungers and levers, instead of endeavoring to prove that there is no conflict, respondents’ brief on page 9 quotes the paragraph from Walker next following the one referred to by the Tenth Circuit in its *Richards and Conover* opinion, and which has just been quoted. Respondents’ brief says:

“\* \* \* As stated in Walker on Patents, Deller’s Edition, Vol. 3, Section 470, page 1707:

“‘But one thing may be an equivalent of another in one environment, and not such an equivalent in another. \* \* \* Springs and weights are generally equivalents \* \* \*, but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents.’” (*Respondents’ own omissions and asterisks.*)

That this quotation can in no way help respondents, is clear from the fact that respondents obviously contend that their plungers *do* operate successfully.

The decision of the Court of Appeals for the Ninth Circuit in the instant case, to the effect that the claims are not infringed because the accused tuners are operated by plungers instead of levers as shown in the patent, is clearly in conflict with the opinions of both the United States District Court for the Western District of Oklahoma and the Court of Appeals for the Tenth Circuit. According to the provisions of Rule 38(5b), petitioner is thus entitled to a review of the issue of infringement by this Honorable Court, and in the event that its decision is favorable, he is thereafter entitled to an adjudication of the issue of validity by the District Court in the Ninth Circuit where this case originated, which did not pass upon this issue. This is clear from the Superior Court's ruling in *Triplett et al. v. Lowell et al.*, 297 U. S. 638 at 644, where the court said:

"It follows that want of disclaimer of claims previously held invalid can never be set up as a bar *in limine* to the maintenance of a second suit upon those claims, and any others of the patent, since *the patentee is entitled to invoke in that suit the independent judgment of the court upon the validity of the claims which have been held invalid.*" (Emphasis added.)

And at page 645:

"The court whose jurisdiction is invoked by such a suit must determine for itself validity and ownership of the claims asserted, notwithstanding a prior adjudication of invalidity of some of them, unless those issues have become *res adjudicata*, by reason of the fact that both suits are between the same parties or their privies."

Regarding Respondent's Comments on the  
Other Questions Presented.

In the argument, respondents' brief says: "The patent in suit has been litigated many times over and always unfavorably to the petitioner." This is not the case. The United States District Court for the Western District of Oklahoma ruled in his favor on all issues, stating in Finding 6 [R. Vol. I, p. 53]:

"Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed . . . ."

Moreover, there has never been any decision holding that the patent is both invalid and not infringed. The original holding of the district court in the *Associated* case that the claims were invalid for want of invention was wiped out by the Ninth Circuit Court of Appeals, which then ruled *de novo* that the claims were not infringed. The next decision was that of the Oklahoma court, which held the claims *clearly valid and clearly infringed*. In the instant case, there was no trial and no new ruling on the issue of validity, the summary judgment of the lower court and its affirmance by the appellate court being confined to the single question of infringement, on which both courts merely followed the previous *Associated* decision on the basis of *stare decisis*. The Tenth Circuit Court of Appeals in the *Richards and Conover* case has now reversed the lower court on the issue of validity, but made it very plain that the claims, if valid, *are infringed*. As matters now stand, the situation on both issues is thus just opposite in the two circuits. In the Tenth, the claims would be infringed, if valid; and in the Ninth, the claims are valid, but not infringed. There is consequently no concurrence between the two circuits



on any issue, and respondents' remarks on page 7 of its brief that this Honorable Court will not usually disturb concurrent findings are thus clearly not in point. The situation is manifestly one that calls for the supervisory attention of this Honorable Court in order that the confusion may be removed.

Respondents' remarks regarding Question No. 4 and Question No. 5 are the only ones that may need comment here. Question No. 4 had to do with the propriety of the appellate court's action in enjoining petitioner from proceeding against the Galvin Manufacturing Company, which defended the suit in the Oklohoma action. Respondent says that the appellate court simply made an application of the principle of *Kessler v. Eldred*, 206 U. S. 285, 27 S. Ct. 611, 51 L. Ed. 1065. The principle here was different. In *Kessler v. Eldred*, the patent owner had already lost a case against the manufacturer before bringing any action against a customer. In the instant case, petitioner had already won a case against the customer before the manufacturers case was decided. Moreover, the case against The Richards and Conover Company, which Galvin defended, was filed before the manufacturers (respondents herein) had filed their declaratory judgment action.

Question No. 5 involved the propriety of the appellate court's omission of Claim 5 when determining the scope that the original patent was intended to have. Respondents say on page 12 of their brief that the appellate court

"simply applied with respect to disclaimed claim 5 the well settled rule of law as laid down in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, 55 S. Ct. 455, 79 L. Ed. 1005, 1014 . . ."



The *Altoona* decision had nothing to do with the matter of whether a reissue patent is for the same invention as the original, and the appellate court's *misapplication* of this decision was well brought out in the petition as well as in the brief in support thereof.

### Conclusion.

The instant case comes from a circuit in which the presumption of validity was restored to the claims by the action of the appellate court in wiping out a previous holding of invalidity. The decision herein affirmed a summary judgment on the issue of infringement only. The holding that the claims are not infringed is in direct conflict with the opinions of the United States District Court for the Western District of Oklahoma and the Tenth Circuit Court of Appeals. Accordingly, petitioner is entitled to a review of this case under Rule 35(5b), so that the conflict on infringement may be resolved. In the event that this Honorable Court holds that the claims, if valid, are infringed, then petitioner is entitled to an independent adjudication of that issue in the Ninth Circuit.

Respectfully submitted,

LE ROY J. LEISHMAN,

*Petitioner in Propria Persona.*

